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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/524,205	03/13/2000	Gilbert Allan Segal	POPT-0002	7194

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EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No. 09/54205	Applicant(s) Segal	
Examiner Ahrens, G	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/8/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-42, 44-89 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-42, 44-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Response to Request for Continued Examination(RCE)*

1. This action is issued in reply to applicant's Request for Continued Examination(RCE)(Paper #13) filed 8/25/03 and applicant's Amendent D(Paper #16) filed 10/8/03.
2. Claim 43 was deleted. Independent claims 21,44,45,57,58,65,81 were amended.No new claims were added.
3. Claims 21-42,44-89 as amended, are pending.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-42,44-89 are rejected under 35 USC 103(a) as unpatentable over O'Shaughnessy(US Pat. 5,978,778) in view of Black(US Pat. No: 6,012,042) in view of Jones(US Pat. No: 6,021,397) and further in view of Melnikoff(US Pat. No: 5,784,696).
6. As per amended independent claims 21,44-45,57-58,65,81 O'Shaughnessy teaches a method of identifying financial instruments meeting predetermined criteria(Abstract)(entire document) consisting of retrieving data from at least one data source(Fig 1/1-1)(Fig 2/2-1) and processing the financial instrument data to identify values for a set of searchable parameters corresponding

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to the investment criteria for particular financial instruments included in the financial instrument data(Fig 1/1-2/1-4/1-6/1-10/1-8/1-12)(Fig 2/2-2/2-4/2-6). O'Shaughnessy does not specifically teach accepting user defined search criteria for the searchable parameters. Black teaches user defined and selected analysis techniques which incorporates criteria inherently in the methods chosen(col 10 lines 57-67)(col 11 lines 8-11). Black further teaches a data conversion apparatus(Fig 1/10) and an analysis process engine(Fig 1/20) utilizing rule-based algorithms(Fig 1/28) and analysis results(Fig 1/24) presented to the user. Additionally, Black teaches an improved system for securities analysis(col 3 line 44-50) for families of securities which may include bonds which would include called issues. It would have been obvious to one skilled in the art at the time of the invention to combine O'Shaughnessy in view of Black to teach the above. The motivation to combine is to teach an improved securities analysis system to facilitate the analysis of securities on a computer system that is user defined as enunciated by Black(col 2 lines 60-67)(col 10 lines 57-67). Furthermore, Jones teaches a financial advisory system providing optimized portfolio allocations simulated interactively with a user according to parameters set by the user for facilitating financial product selection(Abstract)(Figs 1-8)(col 2 lines 22-26)(col 3 line 31-col 4 line 59). Jones further teaches a factor module(Fig 3/310) and a portfolio optimization module(Fig 3/340) and a user database(Fig 3/360) as well as a user interface(Fig 3/345) and a simulation processing module(Fig 3/330) and parameter specification(Fig 4/410) as well as exposure determination(Fig 6) for a user. Jones also teaches receiving information regarding the user's risk tolerance(Fig 7/740) and advice processing(Fig 8). It would have been

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obvious to one skilled in the art at the time of the invention to combine O'Shaughnessey in view of Black and further in view of Jones to teach part of the disclosure. The motivation to combine is to teach a financial advisory system that employs advanced techniques to provide financial advice to individuals on how to reach financial goals and which the user can interactively observe the impact of his decisions on reaching the specified financial goals as enunciated by Jones(col 2 lines 13-26). O'Shaughnessey does not specifically teach searching the values identified from the set of searchable parameters for values matching the user defined criteria. Melnikoff teaches this(Abstract)(col 5 line 63-col 6 line 3).O'Shaughnessey does not specifically teach identifying a set of financial instruments corresponding to values for the searchable parameters matching the user-defined search criteria. Melnikoff teaches this(col 5 line 31-col 6 line 40).Melnikoff further teaches a portfolio selection technique based on investment risk and risk-adjusted return(Abstract) including product classes(Fig 2)(Fig 3).Melnikoff also teaches risk tolerance of the user(Fig 4/705) and averaging and annualization(Fig 5C/134/186) and risk-adjusted returns(Fig 6A).It would have been obvious to one skilled in the art at the time of the invention to combine O'Shaughnessey in view of Black in view of Jones and further in view of Melnikoff to teach the above. The motivation to combine O'Shaughnessey in view of Black and further in view of Melnikoff is to teach a method for selection of groupings of securities based on risk definition and measurement as enunciated by Melnikoff(col 5 lines 25-37)(col 5 line 63-col 6 line 3).

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7. As per dependent claims, 22-42,44,46-56,59-64,66-80,82-89 O'Shaughnessy teaches the trading of stocks(Abstract)(Figs 1-2). O'Shaughnessy does not specifically teach the trading of derivatives and commodities. Black teaches the trading of commodities and derivatives including options(col 1 lines 41-45)(col 2 lines 42-67) utilizing a network(col 10 lines 43-56) which incorporates bid-offer spread(Fig 1). O'Shaughnessy does teach stock volatility(col 10 lines 11-28)(col 9 lines 21-32) and Black teaches trading volume(Fig 1/12).Black teaches user defined and selected analysis techniques which incorporates criteria inherently in the methods chosen(col 10 lines 57-67)(col 11 lines 8-11). Black further teaches a data conversion apparatus(Fig 1/10) and an analysis process engine(Fig 1/20) utilizing rule-based algorithms(Fig 1/28) and analysis results(Fig 1/24) presented to the user.Additionally, Black teaches an improved system for securities analysis(col 3 line 44-50) for families of securities which may include bonds which would include called bonds. Furthermore, Jones teaches a financial advisory saystem providing optimized portfolio allocations simulated interactively with a user according to parameters set by the user for facilitating financial product selection(Abstract)(Figs 1-8)(col 2 lines 22-26)(col 3 line 31-col 4 line 59).It would have been obvious to one skilled in the art at the time of the invention to combine O'Shaughnessy in view of Black and further in view of Jones to teach part of the disclosure. The motivation to combine is to teach a financial advisory system that employs advanced techniques to provide financial advice to individuals on how to reach financial goals and which the user can interactively observe the impact of his decisions on reaching the specified financial goals as enunciated by Jones(col 2 lines 13-26).It would have been obvious to one

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skilled in the art at the time of the invention to combine O'Shaughnessy in view of Black in view of Jones and further in view of Melnikoff to teach the above. The motivation to combine O'Shaughnessy in view of Black and further in view of Melnikoff is to teach a method for selection of groupings of securities based on risk definition and measurement as enunciated by Melnikoff(col 5 lines 25-37)(col 5 line 63-col 6 line 3).

***Response to Arguments***

8. Applicant's arguments with respect to claims as listed have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 44,57,81 are further rejected under 35 USC 101 for failing to define a concrete,useful, and tangible output.A computer medium by itself embodying instructions does not define a tangible output.

***Conclusion***

11. **THIS ACTION IS MADE NON-FINAL.**

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12. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

GRA

October 29, 2003

**DR. GEOFFREY R. AKERS, P.E.**  
**PRIMARY EXAMINER**